

Notice of Allowability

Application No.

10/658,241

Examiner

Robert Shiao

Applicant(s)

KOZIKOWSKI ET AL.

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to responses filed on 08/23, 2005.
2. ☒ The allowed claim(s) is/are 17-26 and 42-46, now are 1-15.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

DETAILED ACTION

1. This application claims benefit of the provisional applications:
60/415,616 with a filing date 10/02/2002.
2. Amendment of claims 17, 19-22, 25-26, cancellation of claims 1-16, and addition of claims 42-46 in the amendment filed on August 23, 2005, is acknowledged. No new matter is found. Since the newly added claims 42-46 are commensurate with the scope of the invention, therefore, claims 17-46 are prosecuted in the case.

Responses to Amendment/Arguments

3. Applicant's arguments regarding rejection of claims 17-26 (now are 17-26 and 42-46) under 35 U.S.C. 112, first paragraph, filed on August 23, 2005, have been fully considered and they are persuasive. The processes of making a mixture of acetyl-protected or benzyl-protected (4 β ,8)-oligomers of epicatechin have been found on pages 22-30 of the specification, i.e. Examples 7 –11 for preparing tetramer to heptamer. Therefore, rejection of claims 17-26 (now are 17-26 and 42-46) under 35 U.S.C. 112, first paragraph, has been withdrawn. Since claims 15-16 have been canceled, therefore, rejection of claims 15-16 under 35 U.S.C. 112, first or second paragraph, is obviated herein.

EXAMINER'S AMENDMENT

4. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be

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filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Margaret B. Kelley on October 11, 2005. The application has been amended as follows:

In Claim 17, after "Claim 42", delete "or 43"

In Claim 18, after "Claim 18", delete "(pending)", and insert
--(original)--

In Claim 23, after "Claim 23", delete "(pending)", and insert
--(original)--

In Claim 24, after "Claim 24", delete "(pending)", and insert
--(original)--

In Claim 44, after "The process of Claim", delete "15", and insert
--42 or 43--

In Claim 45, lines 2-3, after "the isolated oligomers.", delete

"The process of Claim 44, further comprising the step of removing the benzyl-protecting groups from the isolated oligomers.--

In Claim 46, lines 2-3, after "by hydrogenolysis.", delete

"The process of Claim 23, wherein the benzyl-protecting groups are removed by hydrogenolysis."

Delete Claims 27-41

Reasons for Allowance

5. The following is an examiner's statement of reasons for allowance:

Claims 17-26 and 42-46 are neither anticipated nor rendered obvious over the art of record, and therefore are allowable. This invention relates to Synthesis of dimeric, trimeric, tetrameric, pentameric, and higher oligomeric epicatechin-derived procyanidins having 4beta,8-interflavan linkages and their use to inhibit cancer cell growth through cell cycle arrest. The closest reference is Romanczyk et al. US 6,207,842, discloses process for preparing procyanidin (4-6 or 4-8) oligomers and their derivatives. The difference between Romanczyk et al. and instant claims is that the instant processes are not found in Romanczyk et al. Suggestion for modification of above record to obtain the instant claimed processes has not been found. Claims 17-26 and 42-46 are allowed.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably

accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

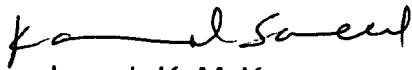
Conclusions

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Shiao whose telephone number is (571) 272-0707. The examiner can normally be reached on 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KAMAL A. SAEED, PH.D.
PRIMARY EXAMINER



Joseph K. McKane
Supervisory Patent Examiner
Art Unit 1626



Robert Shiao, Ph.D.
Patent Examiner
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October 12, 2005